REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-16, 24, 25, 27, and 30-32 are pending in this case. Claims 1 and 31 are amended and new Claim 32 is added by the present amendment. As amended Claims 1 and 31 and new Claim 32 are supported by the original disclosure,[1] no new matter is added.

In the outstanding Official Action, Claims 1, 2, 6, 9-11, 13, 25, 27, 30, and 31 were rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman (U.S. Patent No. 6,453,471) in view of Marshall et al. (U.S. Patent No. 6,419,137, hereinafter "Marshall") and Picco et al. (U.S. Patent No. 6,029,045, hereinafter "Picco"); Claim 3 was rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco and further in view of Hölzle et al. (U.S. Patent No. 5,970,249, hereinafter "Hölzle"); Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco and further in view of Winston (U.S. Patent No. 6,434,653); Claim 7 was rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco and further in view of Russo (U.S. Patent No. 5,619,247); Claim 8 was rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco and further in view of Kostreski et al. (U.S. Patent No. 5,729,549, hereinafter "Kostreski"); Claims 12 and 24 were rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco and further in view of Trovato (U.S. Patent No. 6,701,526); and Claims 14-16 were rejected under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco and further in view of Inoue et al. (U.S. Patent Publication No. 2002/0016963 A1, hereinafter "Inoue").

[1]See, e.g., the specification at page 12, lines 1-24.

With regard to the rejection of Claims 1 and 30 under 35 U.S.C. §103(a) as unpatentable over Klosterman in view of Marshall and Picco, that rejection is respectfully traversed.

Amended Claim 1 recites in part "at least some of the sets of the plurality of sets of the broadcast data service data being transmitted according to an alternative ***data compression protocol*** to that used for the digital television data."

Thus, in the invention recited in Claim 1, the system provides a single broadcast signal which includes broadcast digital television data in a first data compression protocol, such as MPEG-2, transmitted together with a plurality of sets of broadcast data service data in a second data compression protocol, such as MPEG-4. In this example where the first data compression protocol is MPEG-2 and the second data compression protocol is MPEG-4, the more efficiently compressed format MPEG-4 allows the system to provide more of the plurality of sets of broadcast data service data with the broadcast digital television data in the single broadcast signal. It is noted that these data compression protocols are simply provided as an exemplary embodiment, and any data compression protocols known in the art may be used and be within the scope of the claimed invention.

The outstanding Office Action conceded that Klosterman and Marshall do not teach this subject matter and cited Picco as describing this feature.[2]

Picco describes a data transmission system where local content can be transmitted to a set-top box using several different transmission strategies. These strategies include different private data downloading techniques.[3] However, Picco does not describe that the local content is downloaded using a different ***data compression*** protocol. Therefore, it is respectfully submitted that Picco does not teach or suggest a system for providing a plurality of sets of broadcast data service data transmitted together with broadcast digital television

[2]See the outstanding Office Action at page 4, line 4 to page 5, line 20.
[3]See Picco, column 9, lines 10-60.

data as part of a broadcast signal wherein "at least some of the sets of the plurality of sets of the broadcast data service data being transmitted according to an ***alternative data compression protocol*** to that used for the digital television data" as defined in amended Claim 1.

Consequently, as the combination of Klosterman, Marshall, and Picco does not teach each and every element of amended Claim 1, Claim 1 (and Claims 2-16, 24, 25, 27, and 32 dependent therefrom) is patentable over Klosterman in view of Marshall and Picco.

Claim 30 recites in part:

> a processor configured to periodically extract all of the plurality of sets of the broadcast data service data from a broadcast carousel included in the broadcast signal;
>
> ***a memory configured to store all of the current plurality of sets of the broadcast data service data***; the broadcast data service data defining a plurality of digital audio/video data sets, the digital audio/video data sets including television clips;
>
> a display configured to provide a list of a plurality of sets of the digital audio/video data sets; and
>
> a controller responsive to a user initiated selection signal to cause the memory to output a user selected one of the plurality of digital audio/video data sets selected from the list simultaneously with continued receipt of the broadcast digital television data, the selected one of the broadcast data service data plurality of sets having digital audio/video data, ***the digital audio/video data of the broadcast data service data being configured in the broadcast signal for reception at a rate slower than an audio/video replay rate for the selected set***, the selection signal being provided at any time during receipt of the broadcast digital television data and independently of the broadcast digital television data and the controller is responsive at any time during receipt of the broadcast digital television data and independently of the broadcast digital television data to output said selected portion;
>
> wherein ***the processor converts the digital audio/video data of the plurality of sets of the broadcast data service data into real time audio/video data having a real time audio/video replay rate***.

The outstanding Office Action conceded that Klosterman does not teach or suggest the above highlighted features and cited Marshall as describing these features.[4] However, it is respectfully noted that Klosterman discloses a method for transmitting reduced bandwidth trailers for display in a window,[5] and also a method of transmitting the trailer so that there is no perceptible delay.[6] Thus, according to Klosterman, there would be no need or consideration of transmitting video/audio data in non-real time. Therefore, to combine Klosterman with Marshall to add such a feature would change the principle of operation of Klosterman, requiring a substantially redesign of the device described by Klosterman. It is respectfully noted that *In re Ratti* holds that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP §2143.01. Consequently, as there is no suggestion or motivation to make the proposed combination, Claim 30 (and Claim 31 dependent therefrom) is also patentable over Klosterman in view of Marshall and Picco.

With regard to the rejection of Claim 3 as unpatentable over Klosterman in view of Marshall and Picco and further in view of Hölzle, it is noted that Claim 3 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Hölzle does not cure any of the above-noted deficiencies of Klosterman, Marshall, and Picco. Accordingly, it is respectfully submitted that Claim 3 is patentable over Klosterman in view of Marshall and Picco and further in view of Hölzle.

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[4]See the outstanding Office Action at page 10, lines 1-12.
[5]See Klosterman, column 2, lines 62-65.
[6]See Klosterman, column 10, lines 40-44.

With regard to the rejection of Claims 4 and 5 as unpatentable over Klosterman in view of Marshall and Picco and further in view of Winston, it is noted that Claims 4 and 5 are dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Winston does not cure any of the above-noted deficiencies of Klosterman, Marshall, and Picco. Accordingly, it is respectfully submitted that Claims 4 and 5 are patentable over Klosterman in view of Marshall and Picco and further in view of Winston.

With regard to the rejection of Claim 7 as unpatentable over Klosterman in view of Marshall and Picco and further in view of Russo, it is noted that Claim 7 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Russo does not cure any of the above-noted deficiencies of Klosterman, Marshall, and Picco. Accordingly, it is respectfully submitted that Claim 7 is patentable over Klosterman in view of Marshall and Picco and further in view of Russo.

With regard to the rejection of Claim 8 as unpatentable over Klosterman in view of Marshall and Picco and further in view of Kostreski, it is noted that Claim 8 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Kostreski does not cure any of the above-noted deficiencies of Klosterman, Marshall, and Picco. Accordingly, it is respectfully submitted that Claim 8 is patentable over Klosterman in view of Marshall and Picco and further in view of Kostreski.

With regard to the rejection of Claims 12 and 24 as unpatentable over Klosterman in view of Marshall and Picco and further in view of Trovato, it is noted that Claims 12 and 24 are dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Trovato does not cure any of the

above-noted deficiencies of Klosterman, Marshall, and Picco. Accordingly, it is respectfully submitted that Claims 12 and 24 are patentable over Klosterman in view of Marshall and Picco and further in view of Trovato.

With regard to the rejection of Claims 14-16 as unpatentable over Klosterman in view of Marshall and Picco and further in view of Inoue, it is noted that Claims 14-16 are dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Inoue does not cure any of the above-noted deficiencies of Klosterman, Marshall, and Picco. Accordingly, it is respectfully submitted that Claims 14-16 are patentable over Klosterman in view of Marshall and Picco and further in view of Inoue.

New Claim 32 is supported at least by the specification at page 12, lines 1-24. As new Claim 32 is dependent from Claim 1, Claim 32 is patentable for at least the reasons described above with respect to that claim. Further, Claim 32 recites subject matter that further defines over the cited references. Accordingly, Claim 32 is also believed to be in condition for allowance.

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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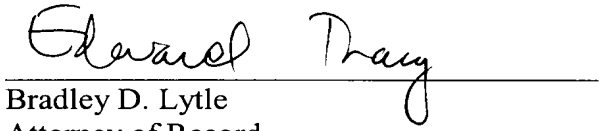

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